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MAR 15 2006

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S/N 155,418

OFFICE OF PETITIONS <sup>PATENT</sup>

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Craig R. Burfeind et al.	Examiner:	Victor J. Taylor
Serial No.:	10/004,623	Group Art Unit:	2863
Filed:	December 3, 2001	Docket No.:	14305.6USC1
Title:	GENERATION AND DISTRIBUTION OF PERSONALIZED MULTIMEDIA NATURAL PHENOMENOLOGICAL INFORMATION		

CERTIFICATE UNDER 37 CFR 1.8:  
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, Washington, D.C. 20231 on March 8, 2006.  
  
By: Cyndee Krenos  
Name: Cyndee Krenos

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED  
UNINTENTIONALLY UNDER 37 C.F.R. § 1.137(b)**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

The above-identified patent application became abandoned because a response to an office action was not timely filed and the period for obtaining an extension of time to file the response under 37 C.F.R. § 1.136 has expired. Enclosed as Exhibit A is a copy of the Notice of Abandonment mailed October 1, 2003.

On December 23, 2003, Applicants' representatives filed a response to the Office Action, along with a petition under 37 C.F.R. § 1.181 requesting that the holding of abandonment be withdrawn. A copy of this petition, including the response to the Office Action, is included herein in its entirety as Exhibit B. This previously filed petition included three declarations by individuals, Nick Johns, Richard Gregson, and Jodi Gandel-Klein, who had knowledge of the events explained below at the time the events took place. These declarations are hereby incorporated by reference.

A response identical in substance to the response filed with the previous petition is enclosed with this document (37 C.F.R. § 1.137(b)(1)). This response has been signed by attorney Erik Swenson, who is currently prosecuting this case. Applicants respectfully request that this response be entered in the present case.

Enclosed herewith is a check in the amount of \$750.00 to cover the fee for filing the petition to revive (37 C.F.R. § 1.137(b)(2)). Please charge any additional fees or credit any overpayment to Account No. 13-2725.

Applicants did not intend to abandon this application. As explained below, the entire delay in filing the above reply from the due date for the reply until the filing of this petition was unintentional (37 C.F.R. § 1.137(b)(3)).

On February 4, 2003, a terminal disclaimer was filed that dedicated to the public a terminal part of the term of any patent granted in the above-captioned case that would extend beyond the date 20 years from the filing of the parent application, U.S. Patent Application No. 09/374,168, filed on August 13, 1999, now U.S. Patent 6,360,172 B1, issued March 19, 2002 (37 C.F.R. § 1.137(b)(4)).

Applicants Did Not Intentionally Delay in Responding to the Office Action

The above-identified application was filed by the Applicants on December 3, 2001, via legal counsel at Schwegman, Lundberg, Woessner & Kluth ("Schwegman"). See Johns Declaration, ¶ 3. This application is assigned to Digital Cyclone, Inc. ("Digital Cyclone"). *Id.* Digital Cyclone holds several related patent applications in the field of personalized multimedia.

On February 28, 2003, Digital Cyclone transferred all of its files from Schwegman to Merchant & Gould, where this case is now being prosecuted. See Johns Declaration, ¶ 4. On March 10, 2003, papers were filed with the U.S.P.T.O. granting Merchant & Gould power of attorney in this matter, and directing future correspondence to Merchant & Gould. See Johns Declaration, ¶ 5. Fourteen days later, on March 24, 2003, a first Office Action was mailed. See Johns Declaration, ¶ 6. Unfortunately, this Office Action was mailed to Schwegman, Applicant's previous legal representative. *Id.* Schwegman took steps to notify Applicants of the Office Action, and eventually the Office Action was received by Merchant & Gould. See Johns Declaration, ¶ 7.

At Merchant & Gould, correspondence from the U.S.P.T.O. is routed through a docketing department and is entered into a computerized docketing system to ensure a timely response. See Johns Declaration, ¶ 8. Because the Office Action was forwarded to Merchant & Gould through an intermediary, it was not identified as correspondence from the U.S.P.T.O., and was never entered into the docketing system. See Johns Declaration, ¶ 9. For this reason, Applicants unintentionally failed to respond to the Office Action within the permissible six-month period. Id.

Upon transfer of Digital Cyclone's files to Merchant & Gould in February 2003, Richard Gregson was assigned to prosecute this application. See Gregson Declaration, ¶ 2. Mr. Gregson prosecuted this application until his departure from Merchant & Gould on September 30, 2003. Id.

On July 9, 2003, Mr. Gregson conducted a telephone interview with the Examiner assigned to this application. See Gregson Declaration, ¶ 3. According to an Interview Summary mailed with the Notice of Abandonment, Mr. Gregson "indicated that the applicants would not respond and that the case was abandoned." In fact, Mr. Gregson made no such statement. See Gregson Declaration, ¶ 3-5.

According to Mr. Gregson, the topic of how the Applicants might respond to the Office Action came up during the telephone interview. See Gregson Declaration, ¶ 4. Mr. Gregson told the Examiner that he would have to discuss this matter with the client, because the client held several related patent applications, and the response in the present case needed to be determined in light of issues in the other applications. See Gregson Declaration, ¶ 4. At no point did Mr. Gregson state or suggest that the client intended to abandon the application or fail to respond to the Office Action. See Gregson Declaration, ¶ 5.

Applicant's counsel respectfully points out that the Interview Summary makes reference to an event that occurred on September 26, 2003, meaning that the Interview Summary was written no earlier than that date. Thus, the Interview Summary was written nearly three months after the telephone interview was conducted. The passage of time may have caused the Examiner to forget the exact substance of the telephone interview.

Additionally, Applicant's counsel respectfully makes the following observations. On September 25, 2003, representatives from Digital Cyclone and attorneys from Merchant & Gould

(including Mr. Gregson) met to discuss strategy. See Johns Declaration, ¶¶ 11-13. During that meeting, this application was discussed. Id. This application figures prominently in Digital Cyclone's strategy. Id. At no point in time did the topic of this case having been abandoned, or at risk of being abandoned, ever arise. Id. It is unthinkable that the topic of abandonment of this case would not have arisen if Mr. Gregson had been aware that this case was abandoned or at risk of being abandoned. Moreover, at the time of the telephone interview, a significant number of claims had already been allowed and more than two months of extendable time in which to respond to the Office Action remained. There would have been no reason for Mr. Gregson to expressly abandon the application at such a time.

#### This Petition Has Not Been Intentionally Delayed

As mentioned above, the Merchant & Gould attorney originally assigned to prosecute this case left Merchant & Gould on September 30, 2003, one day prior to the mailing of the Notice of Abandonment. Between receiving the Notice of Abandonment on October 1, 2003 and December 23, 2003, Applicants' representatives investigated the matter and determined the appropriate manner in which to proceed. In particular, on December 23, 2003, Applicants' representatives filed a petition under 37 C.F.R. § 1.181 requesting that the holding of abandonment be withdrawn. A copy of this petition, as previously indicated, is included herein in its entirety as Exhibit B. A copy of the Express Mail label is also included as Exhibit C, showing that the petition was mailed on December 23, 2003.

As time passed without response, Applicants' representatives became concerned regarding the status of the Petition. Numerous attempts were made to contact the U.S.P.T.O. regarding the petition, but were unsuccessful at obtaining any response. On January 27, 2005, Applicants mailed a Communication to Mail Stop Petitions regarding the lack of response to the petition. A copy of this Communication is enclosed as Exhibit D. A copy of the return postcard is also included as Exhibit E.

Finally, a decision denying the petition was mailed on January 26, 2006. The decision suggested filing an amendment under 37 C.F.R. § 1.137(a) or (b) requesting that the application be revived. The current petition under 37 C.F.R. § 1.137(b) has been filed within two months of


the receipt of the decision on the petition. Applicants have not intentionally delayed in filing this petition.

Applicants request that the petition for revival under 37 C.F.R. § 1.137(b) be approved.



MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, MN 55402-0903  
612.332.5300

Dated: March 8, 2006

Signed:   
Name: Erik G. Swenson  
Reg. No.: 45,147

EGS/JKS:ck

A



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/004,623

12/03/2001

Craig Burfeind

1081.001US2

1581

23552

7590

10/01/2003

MERCHANT &amp; GOULD PC

P.O. BOX 2903

MINNEAPOLIS, MN 55402-0903

RG

14305.6USC1

14035.6USC1 ✓

EXAMINER

TAYLOR, VICTOR J

ART UNIT

PAPER NUMBER

2863

DATE MAILED: 10/01/2003

REV APP/PTA: NOV 24, 2003

REV LEMO: Mar 24, 2004

FIN REV: Sept 24, 2004

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MAR 15 2006

Please find below and/or attached an Office communication concerning this application or proceeding.

OFFICE OF PETITIONS

**Notice of Abandonment**

Application No.

10/004,623

Examiner

Victor J. Taylor

Applicant(s)

BURFEIND ET AL.

Art Unit

2863

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address.

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MAR 15 2006

**OFFICE OF PETITIONS**

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 24 March 2003.
  - (a) ☐ A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b) ☐ A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.  
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c) ☐ A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a) ☐ The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b) ☐ The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a) ☐ Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☒ The reason(s) below:

Item 7 - Other reasons for holding abandonment: The attorney for the applicant Richard J. Gregson # 41804 has indicated that the applicant intends to abandon the application and no response has been received on a timely basis.

VJ Taylor  
ART UNIT 2863  
VJ Taylor

John Barlow John Barlow  
Supervisory Patent Examiner  
Technology Center 2800

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

## Interview Summary

Application No.

10/004,623

Applicant(s)

BURFEIND ET AL.

Examiner

Victor J. Taylor

Art Unit

2863

All participants (applicant, applicant's representative, PTO personnel):

(1) Victor J. Taylor.

(3) \_\_\_\_\_.

(2) Richard J. Gregson # 41804.

(4) \_\_\_\_\_.

Date of Interview: 09 July 2003.

Type: a) ☒ Telephonic b) ☐ Video Conference  
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

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**OFFICE OF PETITIONS**Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: 18-66.Identification of prior art discussed: US 5,654,886.Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Final Rejection, Terminal Disclaimer and response to the final, the attorney for the applicant indicated that the applicant would not respond and that the case was abandoned. No response has been submitted as of 09/25/2003. An attempt was made to reach the applicants attorney on 09/02/2003 and on 09/26/2003 and was not successful. The case stands abandoned as advised by the attorney on 07/09/2003.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Victor J. Taylor  
Examiner's signature, if required



S/N 10/004,623

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: BURFEIND ET AL. Examiner: Taylor, Victor J.  
Serial No.: 10/004,623 Group Art Unit: 2863  
Filed: December 3, 2001 Docket No.: 14305.6USPTO  
Title: GENERATION AND DISTRIBUTION OF PERSONALIZED MULTIMEDIA  
NATURAL PHENOMENOLOGICAL INFORMATION

RECEIVED

MAR 15 2006

OFFICE OF PETITIONS

CERTIFICATE UNDER 37 CFR 1.10

'Express Mail' mailing label number: EV322887254US  
Date of Deposit: December 23, 2003

I hereby certify that this paper or fee is being deposited with the United States Postal Service 'Express Mail Post Office To Addressee' service under 37 CFR 1.10 on the date indicated above and is addressed to the Mail Stop Petition, Commissioner of Patents and Trademarks, Alexandria, Virginia 22313-1450

By:

Name: Teresa Anderson

*Teresa Anderson*

**PETITION UNDER 37 CFR §1.181 FOR WITHDRAWAL OF HOLDING OF  
ABANDONMENT**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This petition, filed under 37 CFR §1.181, seeks withdrawal of a holding of abandonment in the above-identified case. Applicants were made aware of the abandonment via a Notice of Abandonment mailed on October 1, 2003. This petition requires no fee. MPEP §711.03(c). If the Examiner believes that a fee is due, please charge Deposit Account No. 13-2725.

On February 4, 2003, a terminal disclaimer was filed that dedicated to the public a terminal part of the term of any patent granted in the above-captioned case that would extend beyond the date 20 years from the filing of the parent application, U.S. Patent Application No. 09/374,168, filed on August 13, 1999, now U.S. Patent 6,360,172 B1, issued March 19, 2002.

### **Statement of Facts**

The above-identified application was filed by the Applicant on December 3, 2001, via legal counsel at Schwegman, Lundberg, Woessner & Kluth ("Schwegman"). See Johns Declaration, ¶ 3. This application is assigned to Digital Cyclone, Inc. ("Digital Cyclone"). Id. Digital Cyclone holds several related patent applications in the field of personalized multimedia.

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Upon transfer of Digital Cyclone's files to Merchant & Gould in February 2003, Richard Gregson was assigned to prosecute this application. See Gregson Declaration, ¶ 2. Mr. Gregson prosecuted this application until his departure from Merchant & Gould on September 30, 2003. Id.

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According to Mr. Gregson, the topic of how the Applicant might respond to the Office Action came up during the telephone interview. See Gregson Declaration, ¶ 4. Mr. Gregson told the Examiner that he would have to discuss this matter with the client, because the client held several related patent applications, and the response in the present case needed to be determined in light of issues in the other applications. See Gregson Declaration, ¶ 4. At no point did Mr. Gregson state or suggest that the client intended to abandon the application or fail to respond to the Office Action. See Gregson Declaration, ¶ 5.

### Remarks

#### The Holding of Abandonment Should be Withdrawn Because Notice Was Sent To The Incorrect Address

Applicant's counsel respectfully submits that the holding of abandonment should be withdrawn because the United States Patent and Trademark Office failed to mail the Office Action in question to the correct address. This failure comes in the wake of Applicant's counsel having instructed the U.S.P.T.O. to address future correspondence to Merchant & Gould.

Had the U.S.P.T.O. correctly addressed the Office Action, it would have been docketed, and timely response would have been provided. Instead, Merchant & Gould received the Office Action through informal means, and the Office Action was never docketed. For this reason, at the time the Notice of Abandonment was received, a search of the file jacket and docket records indicate that the Office Action was never received from the U.S.P.T.O. See Johns Declaration, ¶ 10. A copy of the docket record where the Office Action would have been entered and docketed is enclosed herewith. See Declaration of Jodi Gandel-Klein in Support of Petition to Withdraw Holding of Abandonment, ¶¶ 1-7.

#### Mr. Gregson Did Not Expressly Abandon This Application

The Applicant's counsel respectfully points out that the Interview Summary makes reference to an event that occurred on September 26, 2003, meaning that the Interview Summary was written no earlier than that date. Thus, the Interview Summary was written nearly three months after the telephone interview was conducted. The passage of time may have caused the Examiner to forget the exact substance of the telephone interview.

The Applicant's counsel respectfully makes the following observations. On September 25, 2003, representatives from Digital Cyclone and attorneys from Merchant & Gould (including Mr. Gregson) met to discuss strategy. See Johns Declaration, ¶¶ 11-13. During that meeting, this application was discussed. Id. This application figures prominently in Digital Cyclone's strategy. Id. At no point in time did the topic of this case having been abandoned, or at risk of being abandoned, ever arise. Id. It is unthinkable that the topic of abandonment of this case would not have arisen if Mr. Gregson had been aware that this case was abandoned or at risk of being abandoned. Moreover, at the time of the telephone interview, more than two months of extendable time in which to respond to the Office Action remained. There would have been no reason for Mr. Gregson to expressly abandon the application at such a time.

This Petition Has Not Been Intentionally Delayed

The MPEP indicates that this petition may be dismissed "where the record indicates that the applicant intentionally delayed in filing the petition." See MPEP 711.03(c). As mentioned above, the Merchant & Gould attorney originally assigned to prosecute this case left Merchant & Gould on September 30, 2003, one day prior to the mailing of the Notice of Abandonment. The period of time between receipt of the Notice of Abandonment and the present has been spent investigating this matter and determining the appropriate manner in which to proceed—a task made difficult due to the departure of the aforementioned attorney. The applicant has not intentionally delayed in filing this petition.

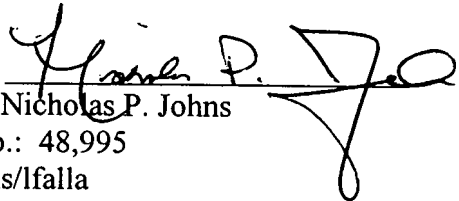
Conclusion

Applicants respectfully petition for withdraw of the holding of abandonment of the above-captioned application. Applicants thank the Commissioner for consideration of this matter. Should any further input be required to resolve this matter, the Commissioner is urged to contact the undersigned by telephone at the number below to expeditiously bring this matter to a close. Should any fees be required for the filing of this Petition, please charge Deposit Account No. 13-2725

Respectfully submitted,

MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, MN 55402-0903  
612.332.5300

Dated: 23 Dec 2003

Signed:   
Name: Nicholas P. Johns  
Reg. No.: 48,995  
NPJohns/Ifalla